

REMARKS

Claims 1-72 are pending in the above-identified application. Of the above claims, 1-49, 53, and 57-66 are withdrawn from consideration. Claims 50-52, 54-56 and 67-72 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,694,726 to Wu in view of U.S. Patent 6,112,481 to Schiedegger et al. This action was made final. Applicant cancels claims 50-52, 54-56 and 67-72 and submits new claims 73 – 80. In view of the prior art cited and the Examiner's contentions, Applicant now presents eight (8) new claims, 73-80, all of which are directed to basic differences between the prior art cited and the claimed invention, which differences Applicant points out below.

The Examiner states that "Wu discloses an elongated horizontal trim product (2) for concealing the gap between and [sic] upper portion and a vertical wall portion of a building comprising a profile of flat and curved surfaces. A first portion is horizontally retained on the upper portion and covered by the trim when mounted to a mating support (upper 11, Figure 1). The second edge is retained by the lower portion of the support structure (lower 11, Figure 1). The fastener is concealed by the trim product." The Examiner states that "Wu does not disclose the use of a molded block member secured proximate the vertical wall and substantially filling the interior of the trim product." However, the Examiner argues that "Schiedegger et al. discloses a trim member bolstered by a foam block (79, Figure 7A), which conforms to the interior profile of the trim product." The Examiner asserts that "in view of prior art to Schiedegger et al., it would be obvious to one of ordinary skill in the art at the time the invention was made to fill the interior of Wu's trim product with a molded block member, as prior art to Schiedegger et al. teaches that such structure improves the structural rigidity of the trim product to facilitate securement to the wall (column 8, lines 26-31), and Wu is concerned with providing an assembly that is easy to install (column 1, line 8), positioned, and firmly secured to the wall (column 2, lines 10-11)."

Applicant teaches the concept of securing the stiffening block to a vertical building surface by adhesive or other fastener means (see page 12, lines 11-12), and also teaches the concept of forming the trim product such that it can be supported by and

closely fitted to the stiffening block (Figures, 6A, 6B, 6C) before other support means, such as soffit 84 in Figure 6C is added. This has a significant advantage that cannot be addressed by either of the cited prior art references, both of which require that a support plate (such as the retainer plate 1 of Wu or the vertical hanger member 36 of Schiedegger et al.) be secured to the wall before the trim product or block are installed, whereas the Applicant teaches and claims securing the stiffening block directly to the wall by way of adhesive or other fastener means.

Contrary to the Examiner's statement that "Schiedegger et al. teaches that such structure improves the structural rigidity of the trim product to facilitate securement to the wall (column 8, lines 26-31)," Schiedegger et al. does not contain an enabling disclosure, so the rejection is unsupported by the art and should be withdrawn. Nowhere does Schiedegger et al. describe the manner and method of using the molded block as a means to support the trim product during installation as described in Applicant's claimed invention. Schiedegger et al.'s specification, specifically that described and pointed out by the Examiner (col. 8, lines 26-31), does not permit one reasonably skilled in the art to make and use the claimed invention without undue experimentation from the information in the specification coupled with the information known to those reasonably skilled in the art. United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). In column 8, lines 26-21, Schiedegger et al. merely states that "it is also appreciated that the interior area of the vertical molding member 20 could be partially filled with the foam block 79 or one or more interior ribs (not shown) which provide even further structural rigidity to the molding member 20 when the molding member 20 is secured to the wall portion 1." Schiedegger et al. is merely interested in structural rigidity, not in supporting the trim product during application. Applicant's claimed invention specifically provides for using the molded block member to support the trim product. See Exhibits 1-3, 3 photographs, Exhibits 1 and 2 of which illustrate the support of the trim product onto the molded block member, and Exhibit 3 which illustrates the soffit securing the upper-end section of the sheet.

Furthermore, Applicant traverses the rejection based on the invention being obvious and requests reconsideration on the grounds that the Examiner failed to present a

prima facie case for obviousness. Applicant respectfully submits this argument based on the rejection of the prior claims as well as on the basis of the new claims. MPEP §2142 provides that "If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Applicant submits that the Examiner failed to present a prima facie case for obviousness for the following reasons in addition to those already set forth:

a) **The Examiner Failed to Consider All of the Limitations and Failed to Consider the Claims as a Whole.**

The Federal Circuit has continually cautioned against myopic focus on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103(a) requires. *See e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986). In *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), the Federal Circuit held that there was want of prima facie obviousness in that "The mere absence [from the reference] of an explicit requirement ...[of the claim] cannot reasonably be construed as an affirmative statement that ...[the requirement is in the reference]."

Specifically, the prior art does not include the limitation that the molded block member is specifically designed to allow the trim product to be supported by the molded block member. As can be seen in the photographs, attached Exhibits 1-3, this limitation in the claimed invention permits the trim product to be held in place by the molded block member as an ease of installation. Nowhere in Schiedegger et al. is there any such limitation.

b) **The Prior Art Does Not Teach the Problem or Source Addressed by Applicant's Invention.**

In many cases, the solution to a problem, once known, may be obvious, but the recognition of the problem itself, or of the source of the problem, is not obvious. When the Examiner applies prior art to form the basis of a rejection under 35 U.S.C. §103(a),

the Examiner must evaluate what is the patentable discovery made by the Applicant, i.e., the discovery of the problem or the solution to that problem. If the prior art teaches that the solution to the problem is obvious, one must then determine whether the discovery of the problem is taught or suggested by the prior art. If not, this will form the basis for traversing the assertion of prima facie obviousness. Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923).

The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution. (In re Nomiya, 509 F.2d 566, 572, 184 USPQ 607, 612 (CCPA 1975)).

Schiedegger et al. does not recognize the application problems and how to resolve them. Applicant's invention, on the other hand, permits the trim product to be easily installed onto the molded block member, supported and held in place for permanent installation as shown in Applicant's Figures 6A, 6B and 6C. Neither Schiedegger et al. or Wu provide that the molded block member supports the trim product. Rather, both Wu and Schiedegger et al. provide that a bracket supports the trim product rather than a molded block member.

c) **A Reference is not Properly Combinable or Modifiable if Its Intended Function is Destroyed.**

If a prior art reference is cited that requires some identification in order to meet the claimed invention, or requires some modification in order to be properly combined with what is known, and such modification destroys the intended purposes or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. Thus, the CCPA and the Federal Circuit have consistently held that when a §103(a) rejection is based upon a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed modification is not proper, and the prima facie case of obviousness cannot be properly made.

For example, In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), the court cited the lack of a technological motivation for making the modifications necessary to arrive at the claimed invention as evidence that the suggestion for the proposed modification could not have come from the reference itself. “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”

The combination or modification of the references in the manner suggested by the Examiner would render the primary reference inoperable for its intended purpose. MPEP §2143.01 states:

If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Because the facts derived from the references, as set forth below, the suggested combination or modification would render the primary reference inoperable for its intended purpose, the rejection is unsupported by the art and should be withdrawn.

- (i) Wu states [column 2, lines 16-27] that “there is a hollow space defined between the casing 2 and the retainer plate 1. The hollow space may be used to contain wires 3 so as to conceal the wires 3 and preventing them from marring the surface of the wall. Nowhere does Wu indicate that the open space should be used to contain foam molding but instead intended for the space to conceal wires. The modification to Wu would destroy the intended function of Wu.
- (ii) The prior art described and claimed in Wu includes and requires use of a retainer plate 1, which covers the very wall surface to which Applicant’s molded block member is secured. Thus Wu would have to be modified to eliminate the retainer plate and there is no suggestion or motivation to do so and the elimination of the retainer plate would prevent the attachment of the casing to the wall.
- (iii) The prior art described and claimed in Schiedegger et al. includes and requires in his Figure 7A attaching a hanger member 36 to the wall and then attaching the molding member 20 to it. Schiedegger et al. would have to be modified to eliminate his hanger member and there is no suggestion or motivation to do so and the elimination of the hanger member would prevent attachment of his molding member.

- (iv) The fitting assembly described and claimed by Wu is made of plastic and not of a deformable metal material. Specifically the assembly described and claimed by Wu to provide for concealing gaps [column 1, lines 34-37] is composed of a soft extension strip.

d) **The Examiner Failed to Find a Basis for Modifying the Reference.**

As the court stated In re Mills, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990), the mere fact that a reference can be combined with known prior art or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. ACS Hospital Systems, Inc. v. Monteffiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. In re Sang Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

There is no intrinsic or extrinsic justification for modifying Wu to accept the molded plastic member. Nor is there any intrinsic or extrinsic evidence to modify Schiedegger et al. to permit the mounting and easy attachment of the sheet metal onto the foam member as in the claimed invention.

e) **Prima Facie Case Requires a Reasonable Expectation of Success: "Obvious to Try" a Modification or Combination of a Reference with Known Prior Art Does not Establish a Prima Facie Case of Obviousness.**

The Federal Circuit has stated that there must be some reason or suggestion found in the prior art or other evidence of record that would have led one of ordinary skill in the art to produce the claimed invention in order to properly establish a prima facie case of obviousness. In re Clinton, *supra*. Thus, one cannot base obviousness on what a person skilled in the art might try or might find obvious to try, but rather must consider what the prior art would have led a person skilled in the art to do. "Obvious to try" is an improper

basis for a §103(a) rejection when there is no suggestion, or expressed expectation, of success in the prior art that would have lead one to perform the experimentation in the first place.

Applicant respectfully submits that the new claims are clearly allowable for the reasons stated above and therefore requests such allowance.

Respectfully submitted,


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